

## II. REMARKS

The Examiner is requested to enter the amendment and reconsider the application. It is believed that no new matter has been added by the amendment. The amendment to the Specification is to place the priority claim in proper format according to 37 C.F.R. §1.78, and to correct certain typographical errors the Examiner has pointed out in the Office Action.

Applicant respectfully requests an interview prior to the next Office Action.

In the Office Action, on the Office Action Summary page, under Disposition of claims, Box 4 is checked and states that claims 1-37 is/are pending in the application. Box 6 is also checked and states that claims 1-67 is/are rejected. Applicant understands that Boxes 4 and 6 contain a typographical error, and that claims 1-60, and 62-67 are pending in the application. Two claims numbered 61 were filed, and one of the claims 61 is cancelled and resubmitted as claim 67. The statement made by the Examiner on page 2 of the Office Action, "Claims 1-67 have been examined" also helps clarify that 67 claims are pending in the application.

In the Office Action on pages 2-3, the Examiner contends the Applications claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) does not comply with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e). Particularly, the Examiner contends that the disclosure of Ser. No. 60/603,608 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application because Ser. No. 60/603,608 only contains Drawings 1 and 15 of the present application, and the content of claims 1-84 is not disclosed in said application. In particular, the Examiner contends that there is no support in a prior-filed application for the limits (or their equivalent) "allocating the components to different parties, one of the parties from a group including an insurance risk carrier and a source of an asset for said reserve requirement; and assigning an asset for the reserve requirement to a reinsurance asset trust to receive reinsurance credit."

In response, the rejection is respectfully traversed because the Examiner has not set out a prima facie case of non-enablement pursuant to Sec. 112 so as to negate priority pursuant to Sec. 119(e). Applicant respectfully understands that claims 1-67 are pending in this application, and not claims 1-84. In regard to claims 1-67, the Examiner's attention is drawn to the discussion in on page 4 and the top of page 5 of Ser. No. 60/603,608, starting with the first full paragraph on page 4, which discloses that pieces are spread to insurers, retrocessionaire, etc. on the insurance risks and to the capital markets for the reserve requirements. Support is also shown in the drawings attached to Ser. No. 60/603,608. The support is present, but just in different words.

Similarly, with respect to Ser. No. 60/517,180, attention is drawn to the specification beginning on page 2, which describes in some detail the breaking apart of the insurance and reserves and placing it with separate parties. It is similar to the '680, and even uses the term "bifurcation". See also, Figure 1, which clearly shows the splitting (segmenting) of the risks. In view of the disclosure in both provisional patent applications, the Office Action does not set out a case of lack of enabling disclosure. However, in view of the different words used in the provisional, Applicant requests an interview.

In the Office Action on page 3, the Examiner has objected to the Abstract because 1) it does not comments on a separate sheet in accordance with 37 C.F.R. 1.52(b)(4); and 2) for the use of legal phraseology in the abstract, particularly the words "means" and "said" and otherwise as set out in the Office Action.

In response, it appears that the Examiner is reacting to the PCT transmittal of its application. The rejection is believed to be moot in that Applicant is filing a substitute specification which has the Abstract commencing on a separate sheet. Also, the Abstract has been amended to remove the words "means" and "said". A Substitute Abstract-Clean Version page 31 is enclosed herewith.

In the Office Action on pages 4-5, the Examiner has objected to the drawings under 37

C.F.R. 1.83(b). The Examiner contends that the drawings are incomplete, and requests that corrected drawing sheets in compliance with 37 C.F.R. 1.121(d) be submitted.

In response, Replacement Sheet Figures 1-9 are being submitted herewith.

In the Office Action, on Page 6, the Examiner has objected to the specification because of minor informalities. The Examiner contends that the section labeled "Disclosure" should be corrected to read "Brief Summary of the Invention," and the section labeled "Modes" should be corrected to read "Detailed Description of the Invention."

In response, the objection is respectfully traversed: the CFR makes no requirement as to these titles. However, Applicant has no objection to the amendment of the titles entered without prejudice, has amended said titles, and submits herewith a Substitute Specification-Clean Version pages 1-17 which incorporates the Examiner's preferred section titles.

In the Office Action, on Page 6, the Examiner has objected to claim 49 because of minor informalities.

In response, claim 49 has been amended, and is now dependant from claims 31-32 instead of claims 1-2. Applicant appreciates the Office's correct assuming of the dependencies.

In the Office Action, on page 7, the Examiner rejects claims 31-60, 62-63, 67 pursuant to 35 U.S.C. 112, second paragraph. The Examiner contends that claims 31-60, 62-63, and 67 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, as is more completely set out in the Office Action. The Examiner also contends that claim 66 does not contain a discernable preamble and transition phase, and claims 76-84 are rejected based on their dependence on claim 66.

In response the rejection is respectfully traversed, though Applicant is receptive to any suggestions the Examiner can make. With respect to claims 31-60, however, there is no combining of statutory classes with a machine carrying out steps. And with respect to claims 62-63, the claims appear to correspond in format to Claim 43 approved by the Federal Circuit in *In re*

*Beauregard*. The Examiner is requested to provide “information” pursuant to Rule 104 and Sec. 132 as to any distinction being made between the format of Applicant’s claims and Claim 43 approved by the Federal Circuit in *In re Beauregard*. Further, the Office Action provides no elucidation with respect to the rejection of claim 67, and this claim appears to be clear as to statutory class. As to claim 66, the Office Action contends that there is no preamble and transitional phrase, but attention is drawn to “comprising” as the transitional phrase separating the preamble from the body of the claim. While Applicant is receptive to suggestions, the rejection is improper and not compliant with Rule 104 and 35 U.S.C. Sec. 132 requirements for “information”. Further, as stated above, only claims 1-67 are pending in this application and have been examined. This rejection is respectfully traversed and is believed to be moot in that there are no claims 76-84 currently pending in this application that depend from claim 66.

In the Office Action, on Pages 8-11, the Examiner has rejected claims 1-30 pursuant to 35 U.S.C. 101. The Examiner contends that claims 1-30 are directed to non-statutory subject matter.

In response, the base claim 1 has been amended, and it is believed that the rejection has been overcome.

With respect to the Sec. 101 rejection of claims 31-60, 62-63, and 67 the rejection is respectfully traversed for the reasons set forth above. To briefly reiterate, the claims have not been shown to encompass two statutory classes.

With respect to the Sec. 101 rejection of claims 31-60, it is noted that claims 31-60 are explicitly drawn to “apparatus”, not to any “judicial exception (software) without use of a physical medium” as contended in the Office Action.

In the Office Action, on Pages 11-14, a nonstatutory double patenting rejection has been issued. In response, the rejection is respectfully traversed, but noted in the Office Action as contended “provisional obviousness-type double patenting. Applicant will respond with traversal or a terminal disclaimer or otherwise as appropriate, should the Patent Office acknowledge

patentability of claims.

In the Office Action, on pages 14-22, the Examiner has rejected claims 1-67 pursuant to 35 U.S.C. 103(a). The Examiner contends that claims 1-67 are unpatentable over Hammond (U.S. Patent No. 5,712,984) in view of Brisbois (PGPub Document No. 2005/0216316) and in further view of Tinnirello (PGPub Document No. 2006/0036527).

In response, the rejections are respectfully traversed. First, Tinnirello has not been shown to be prior art. Priority in the instant case extends to PCT Application No. PCT/US04/37000, titled "Computer System Managing an Insurance Reserve Requirement By Segmenting Risk Components in a Reinsurance Transaction," filed November 4, 2004, which in turn claims benefit from US Patent Application Ser. No. 60/517,180 titled, "Computer System for Redundant Insurance Reserve Financing," filed November 4, 2003. Tinnirello's provisional application was subsequently filed on August 16, 2004.

Further, the disclosure in Tinnirello's provisional application differs substantially from the Tinnirello's utility patent application, which has been cited by the Examiner in the Office Action, and the Office Action does not map to the provisional application. Additionally, Tinnirello's utility patent application filing date of August 15, 2005, which is subsequent to the filing date for the PCT application from which the instant national case is derived. Applicant does not concede that Tinnirello is prior art.

Second, Brisbois has not been shown to be prior art. Brisbois is a continuation-in-part of Ser. No. 10/610,374, which adds new matter on its filing date of Sept. 27, 2004, and which different from the provisional application Ser. No. 60/506,361. The Office Action does not map to a prior disclosure to Applicant's priority date, and the September 27, 2004, filing of the Brisbois CIP is subsequent to the filing date for the PCT application from which the instant national case is derived. Applicant does not concede that Brisbois is prior art.

Because the rejection pursuant to Sec. 103 is premised on art which has not been shown

to be “prior”, the rejection is improper.

Third, even if one were to assume that Tinnirello and Brisbois disclosures were prior art, the rejections would still be improper. Applicant seeks to facilitate advancement of the case with assistance to the Examiner, requests an interview, and notes the following: Tinnirello does not teach segmenting economic reserve from a corresponding excess regulatory reserve requirement (Tinnerello instead is directed to using a system to uniformly report data for financial statement for financial regulatory compliance); Hammond does not teach allocating the claimed components to different parties (Hammond instead is directed to predicting incurred costs for insurance carrier, which is only one party); and Brisbois does not teach assigning an asset for the reserve requirement to a reinsurance asset trust (Brisbois is directed to insurance policies maintained in a bond trust and income instrument portfolio maintained in a bond trust in the securitization transaction, and there is no reinsurance asset trust as there is no teaching for a reinsurance transaction). Thus, even if the cited art were all deemed to be “prior”, the rejections for all independent claims would still be improper, and the impropriety compounds into the dependent claims. In sum, a case of prima facie unpatentability under Sec. 103 has not been evidenced.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

**APPLICANT CLAIMS SMALL ENTITY STATUS.** The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed, this shall be deemed a petition therefore

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'PK Trzyna', with a long horizontal flourish extending to the right.

Date: October 27, 2010

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Peter K. Trzyna  
(Reg. No. 32,601)

P.O. Box 7131  
Chicago, IL 60680-7131  
(312) 240-0824